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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,588	04/12/2004	Harland D. Couillard	UPCP 0102 PUS1	3553
22045	7590	09/27/2005		
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			EXAMINER KATCHEVES, BASIL S	
			ART UNIT	PAPER NUMBER
			3635	

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/822,588

Applicant(s)

COUILLARD, HARLAND D.

Examiner

Basil Katcheves

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 15-22 and 36-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-22 and 36-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This new action is non final in view of newly cited prior art.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 15-22 and 36-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 6,748,636. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 15 is a substantial duplicate to claim 34 of '636.

Claim 16 is a substantial duplicate to claim 3 of '636.

Claim 17 is a substantial duplicate to claim 4 of '636.

Claim 18 is a substantial duplicate to claim 5 of '636.

Claim 19 is a substantial duplicate to claim 6 of '636.

Claim 20 is a substantial duplicate to claim 8 of '636.

Claim 21 is a substantial duplicate to claim 9 of '636.

Regarding claim 22, it would have been obvious to adjust the swing weight in order to separate larger and heavier components.

Claim 36 is a substantial duplicate to claim 33 of '636.

Claim 37 is a substantial duplicate to claim 31 of '636.

Claim 38 is a substantial duplicate to claim 31 of '636.

Claim 39 is a substantial duplicate to claim 3 of '636.

Claim 40 is a substantial duplicate to claim 4 of '636.

Claim 41 is a substantial duplicate to claim 5 of '636.

Claim 42 is a substantial duplicate to claim 6 of '636.

Claim 43 is a substantial duplicate to claim 8 of '636.

Regarding claim 44, it would have been obvious to adjust the swing weight in order to separate larger and heavier components.

Claim 45 is a substantial duplicate to claim 33 of '636.

Claim 46 is a substantial duplicate to claim 31 of '636.

Claim 47 is a substantial duplicate to claim 33 of '636.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 38, 39, 43, and 45-47 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,775,674 to Bigham.

Regarding claim 38, Bigham discloses a method of separating a first object (fig. 6: 12) from a second object (fig. 2: floor around hole 16), the method comprising engaging a first element (fig. 6: 48), having a stop (uppermost peak bend), and swinging a second element (fig. 6: 32) supported by support member 20 to engage the stop and separate the first and second objects.

Regarding claim 39, Bigham discloses the 1<sup>st</sup> element (48) as forming a channel (upper section with bend portion) for component 32 to fit within when 33 is swung.

Regarding claim 43, Bigham discloses the elements as supported by support 20.

Regarding claim 45, Bigham discloses the 2<sup>nd</sup> element as applying a horizontal force to the 1<sup>st</sup> element at 90 degrees from its axis.

Regarding claim 46, Bigham discloses the 2<sup>nd</sup> element as swingable between two positions (fig. 6).

Regarding claim 47, Bigham discloses the 2<sup>nd</sup> member as being generally horizontal (fig. 6).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,775,674 to Bigham.

Regarding claims 40-42, Bigham discloses the 1<sup>st</sup> element as extending through the 2<sup>nd</sup> element (through fig. 5:42 as shown in fig. 6) and the basic claim structure of the instant application but does not disclose specific dimensions of cross sections. Applicant fails to show criticality for specifically claimed cross section dimensions, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims.

Regarding claim 44, Bigham discloses the basic claim structure of the applicant but does not specifically disclose adjusting the swing weight of the second element. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bigham by using a heavier or lighter weight against end portion 34 in order to lift weights which may be lighter or heavier than normal.

***Response to Arguments***

Applicant's arguments filed 5/16/05 are moot under new grounds of rejections.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited patents listed on the included form PTO-892 further show the state of the art with respect to swinging separators in general.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Basil Katcheves whose telephone number is (571) 272-6846. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman, can be reached at (571) 272-6842.

BK

  
Basil Katcheves

9/21/05

Primary Examiner AU 3635